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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,925	04/21/1999	PHALGUN B. JOSHI	16303-007510	7753

20350 7590 11/07/2002

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EXAMINER

WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 11/07/2002

27

Please find below and/or attached an Office communication concerning this application or proceeding.

File

**Advisory Action**

Application No.  
**09/295,925**

Applicant(s)  
**Joshi et al.**

Examiner  
**Joseph T. Weitach**

Art Unit  
**1632**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Oct 29, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Oct 29, 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached.

3. ☒ Applicant's reply has overcome the following rejection(s):  
See attached.

4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attached.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-12 and 46

Claim(s) withdrawn from consideration: 13-45

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other:

*Deborah Crouch*  
**DEBORAH CROUCH**  
PRIMARY EXAMINER

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Section 2(a-c):

The proposed amendment of “synchronizing at least 30% of said cells” is a new embodiment not specifically searched nor previously considered. The evaluation of this limitation with respect to anticipation by the art would require a new search, and further consideration under 35 U.S.C. 122, first paragraph, regarding the necessary teaching to achieve this specific level of synchronization. Further, the amendment raises issues regarding 35 US 112, second paragraph, because it is not clear how one would calculate or know the number of cells affected by the treatment.

Additionally, upon review of the specification, literal support for the limitation of “high energy” electromagnetic radiation can not be found, and raises issues regarding new matter. Further, because this term is not specifically defined in the specification it raises issue regarding the metes and bounds encompassed by the term.

Section 3:

Applicants' argument regarding the ability of various spectrums of electromagnetic radiation to synchronize cells at different cell cycle stages has been found persuasive, however the after final claim amendments have not been entered and the instantly pending claims still encompass non-enabled embodiments. Importantly, the ability to synchronize cells with any given form of radiation to any stage of the cell cycle. As indicated by Applicants' comments and by the art of record, clearly each form of radiation affects different parts of the cell cycle.

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Section 6:

The arguments regarding the rejection made under 35 U.S.C. 103 have been considered but not found persuasive because they encompass claim amendments which have not been entered. In particular, to differentiate the instantly claimed invention, the percentage of cells synchronized in the various methods is discussed. However, the pending claims have no specific requirement to the percent number of cells which become synchronized.